THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CLARENCE D. CHANG, SCOTT HAN, DANIEL J. MARTENAK, JOSE G. SANTIESTEBAN and DENNIS E. WALSH

Appeal No. 96-1502
Application 08/169,107[1]

ON BRIEF

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER and LEE, Administrative Patent Judges.

McKELVEY, Senior Administrative Patent Judge.

Decision on appeal under 35 U.S.C. § 134

---

[1] Application for patent filed December 20, 1993. The real party in interest is Mobil Oil Corporation.

The appeal is from a decision of the Primary Examiner rejecting claims 1-16. We reverse-in-part and vacate and remand in-part.

The examiner has entered two rejections.

I.

Claims 1-16 have been rejected as being unpatentable under 35 U.S.C. § 103 over Michaelson, U.S. Patent 3,755,147 (1973).

Upon consideration of the brief on appeal and the examiner's answer, it is

ORDERED that the rejection is reversed essentially for the reasons given in Section A and Section B, Parts 1 and 2 of our opinion in Ex parte Chang, Appeal 96-0460 (Bd. Pat. App. & Int. Feb. 3, 1999) (Paper 22) (copy attached).

II.

Claims 1-16 have been rejected for obviousness type double patenting in view of the claims in the application involved in Appeal 96-0460.

The rejection is vacated and the application is remanded to the examiner for further proceedings.

The examiner concedes that the claims herein and those in the application involved in Appeal 96-0460 are not identical. The examiner maintains, however, that the sets of claims "differ from one another only in the scope of coverage being sought" (Examiner's Answer, page 5). The examiner therefore reasons that "[t]he instant process would have been obvious because of the overlapping scope of the subject matter being claimed" (id.). Answering applicants' argument that the feed stock here and the feed stock in the claims involved in Appeal 96-0460 are different, the examiner again notes an overlap.

The examiner has applied what appears to be a per se rule that if the scope of two sets of claims overlap, one set of claims will render obvious within the meaning of 35 U.S.C. § 103 the other set of claims. There is no such per se rule. On the contrary, each difference must be analyzed and an explanation must be provided as to why the subject matter, as a whole, of one set of claims renders obvious the subject matter, as a whole, of the other set of claims. We decline to undertake that analysis in the first instance and accordingly vacate the examiner's double patenting rejection and remand so

that a proper analysis can be conducted in the first instance by the examiner.

REVERSED-IN-PART and VACATED AND REMANDED-IN-PART

FRED E. McKELVEY, Senior Administrative Patent Judge	)	
RICHARD E. SCHAFER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JAMESON LEE Administrative Patent Judge	)	

Attachment to Opinion

cc (via First Class Mail):

Alexander J. McKillop, Esq.
Office of Patent Counsel
MOBIL OIL CORPORATION
3225 Gallows Road
Fairfax, VA 22037